3752

PTO/SB/21 (02-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/800,153
Filing Date	03-05-2001
First Named Inventor	GREGORY A. SIMS
Art Unit	4533
Examiner Name	C. S. Kim
Attorney Docket Number	MCY-FL 001 P2

Total Number of Pages in This Submission

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☑ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance communication to Technology Center (TC)
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☑ Other Enclosure(s) (please Identify below):

Return Card

Remarks

Reply to Examiner's Answer of June 23, 2004

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Matthew R. Jenkins, Esq.
Signature	
Date	August 12, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Rebecca Lantis		
Signature		Date	August 12, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Inventors	:	Gregory A. Sims
Serial No.	:	09/800,153
Filed	:	March 5, 2001
Title	:	INTEGRATED PEST PREVENTION SYSTEM
Examiner	:	C.S. Kim
Group	:	4533
Docket No.	:	MCY-FL 001 P2

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 8-12-2004.

Rebecca Lantis
Typed or printed name of person mailing paper or fee

Rebecca Lantis
Signature of person mailing paper or fee

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Washington D.C. 20231

Sir:

REPLY TO EXAMINER'S ANSWER

This is a Reply to Examiner's Answer of June 23, 2004.

Remarks

Appellant respectfully submits the following responses to the Examiner's Answer and, more particularly, to the Examiner's arguments in Section 11 (beginning on page 6 of the Examiner's Answer) in order to clarify Appellant's response and/or to traverse the Examiner's new arguments.

Regarding the Examiner's comments relative to Wing and Jackson references on page 6 of the Examiner's Answer, the Examiner states:

> "First, Jackson discloses a port 63. Second, Wing discloses a port (the end opening of tube 40 which is coupled to housing 26 meets the limitation of a 'port'."

Appellant traverses this new argument.

The Examiner appears to be overlooking Appellant's claim language. Appellant respectfully submits that the invention of Claim 1 requires the following element:

> a port mounted in an exterior wall of the building, said port being adapted to receive a discharge portion of a fluid injection device wherein the injection device includes an inert gas inlet, a pesticide inlet, and valve means for selectively providing inert gas and pesticide to the discharge portion,... (emphasis added)

The tubing 40 in Wing is "discharge tubing" and cannot receive a discharge portion of an injection device. Appellant's comments in Appellant's Brief relative to how a technician uses Appellant's system were merely intended to help the Board understand a use of the claimed system.

Appellant argued in its Brief that Jackson did not show a valve or valve means as claimed by Appellant. The Examiner apparently conceded that argument, but now argues that Appellant's argument was misplaced because "Wing teaches such features." The Examiner states:

> Wing discloses, in column 2, line 70, that valves 33 and 34 are normally closed. Wing discloses, in column 4, lines 39-57, selectively opening valve 33 to provide insecticide. Wing then discloses valve 33 and opens valve 34 to provide the propellant gas in container 15. Examiner's Answer, page 6, line 20 to page 7, line 2.

Appellant again emphasizes that the end of tube 40 in Wing cannot receive, and is not adapted to receive, a discharge portion of a fluid injection device as recited in Appellant's claim 1. Neither valve 33 nor valve 34 of Wing can perform the function of an injection device that is adapted to be received in a port as needed in Appellant's claim 1. Further the valves 33 and 34 lack the other features of Appellant's injection device (e.g., valve means for selectively switching, etcetera).

The Examiner's statement that the opening of tube 40, which is coupled to housing 26, meets the limitation of Appellant's "port" is also incorrect because Appellant's claim 1 clearly requires that the port be mounted on an exterior wall of a building and that the port be adapted to receive a discharge portion of a fluid injection device. Accordingly, even if the Examiner's interpretation that the tubing 40 in Wing was a port, it still fails because it is incapable of receiving a discharge portion of a fluid injection device. Also, if it was a port as the Examiner suggests, then it would presumably be open (so it can receive an injection device), which would seem to suggest that the Wing fumigant and gas would escape to the atmosphere when valves 33 and 34 are open. This modification of Wing destroys the teaching of Wing.

Again, the valves 33 and 34 are not injection devices having the gas inlet, pesticide inlet and valve means as recited in Appellant's claim 1. The valves 33 and 34 are incapable of selectively providing inert gas and pesticide to the discharge portion. For these reasons and for the reasons set forth in Appellant's Brief, the Examiner's apparent suggestion to combine these valves is based upon hindsight using the teaching of Appellant's disclosure, which is improper. The Examiner also appears to be modifying the references in a manner that would either destroy the teaching of the references or would require significant engineering changes to one or both references.

In response to Appellant's argument that there is no motivation to combine Jackson and Wing, the Examiner states that the motivation for combining these two references is that, "it's common knowledge and common sense that a 'non-explosive propellant' reduces or eliminates the risk of explosion resulting in a safer device for technicians to operate."

First, there is no motivation or teaching in Jackson, contrary to the Examiner's assertion, that suggests that Jackson uses an explosive propellant, or if it does, that it needs to be modified to use a non-explosive propellant. Indeed, column 3, lines 2-5 suggest a fumigant under pressure, which does not necessarily even suggest the use of a separate explosive propellant of the type referred to in Wing.

Second, even assuming, arguendo, that is proper to combine the non-explosive propellant of Wing with Jackson, the resultant combination (i.e., Jackson used with a non-explosive propellant) fails to teach of Appellant's invention as claimed in claim 1 because Jackson lacks an injection device, which the Examiner concedes on page 3 (fifth paragraph) of the Office Action dated December 24, 2003.

Finally, if the problem to be overcome is eliminating use of an explosive propellant, then there is simply no reason to combine Wing with Jackson. Rather, it would seem that the skilled artisan would rely on the Wing reference alone. Stated another way, there would be no motivation or need to use the device of Jackson with Wing if the goal is to use a non-explosive propellant which Wind teaches alone.

Again, Appellant can find no teaching in Jackson that even suggests that it is using an explosive propellant or the need to use a non-explosive propellant. For the reasons set forth in Appellant's Brief and for the reasons mentioned, Appellant can find no motivation to combine these references and such combination is improper.

Appellant traverses Examiner's statements at the bottom of page 8 and top of page 9 of the Examiner's Answer relative to the limitations of Appellant's claim 1. Appellant respectfully submits that Appellant is not claiming a plurality of elongate tube members alone per se, but rather, Appellant claims these members in combination with the system of claim 1 which comprises the port mounted in an exterior wall of the building, the distribution manifold, a plurality of elongate tubing members, each having fluid discharge openings spaced along the tubing members, where the port is adapted to receive a discharge portion of a fluid injection device wherein the injection device includes an inert gas inlet, a pesticide inlet and a valve means for selectively providing the gas and pesticide to the discharge portion. Appellant is not limiting its claim 1 to one straight tube as the Examiner suggests, and the Board is respectfully directed to the precise elements of Appellant's claims as recited.

Regarding the Examiner's rebuttal relative to the Hill reference, Appellant refers to its arguments in Appellant's Brief, except that Appellant again emphasizes that Wing and Jackson contemplate a permanent reservoir or tank with no motivation to add wheels or any transport capability. Indeed, if wheels were added to the tank 14 of Wing, this would necessarily require that wheels be added to the tank 15, neither of which is contemplated by the Wing reference. Clearly, Wing contemplates a fixed, stationary reservoir which is shown inside the building.

Regarding the Examiner's response to Appellant's argument relative to the Cann reference, the Examiner states, "the subject invention relates to an apparatus and method for **measuring paint usage** in a painting system" (Examiner's original emphasis). Clearly, Cann is a paint system and the device of Cann is intended to be used in a paint system for measuring paint in the paint system as emphasized and

acknowledged by the Examiner. There would be no motivation to add a paint measuring device, to either of Jackson or Wing or the combination of Jackson with Wing. Indeed, neither Jackson nor Wing suggests the need for using any measuring device, let alone a paint measuring device to measure either fumigant or propellant (both of which would seem to be required if such a modification would be made to Wing, for example).

Regarding the Examiner's statements relative to the Konieczynski reference, the Board is respectfully directed to the arguments made in the Appellant's Brief.

Finally, the Examiner seemed to indicate that he would now enter the Amendment of the error of the word "last" to "least." Accordingly, Appellant respectfully withdraws its second issue as to the request that the Board direct the Examiner to enter Appellant's correction of the misspelling. As stated in Appellant's Answer, Appellant will gladly submit a further Amendment to correct the error after the Board's respectful consideration of this Appeal.

For all the foregoing reasons and for the reasons stated in Appellant's Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of claims 1-5 and 7-12.

Respectfully submitted,

JACOX, MECKSTROTH & JENKINS

By _____
Matthew R. Jenkins
Reg. No. 34,844

1205 Manatee Avenue West
Bradenton, FL 34205
Tel: 941-747-0339
August 12, 2004